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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,154	01/31/2001	Robert M. Fries	14531.123.3.	7805
22913	7590	10/05/2004	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			USTARIS, JOSEPH G	
			ART UNIT	PAPER NUMBER
			2616	5
DATE MAILED: 10/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,154

Applicant(s)

FRIES, ROBERT M.

Examiner

Joseph G Ustaris

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-8, 12, 13, and 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith (US006557756B1).

Regarding claim 1, Smith discloses a communications module or “television tuning device” that is “able to at least translate an incoming signal into a picture on a display” (See Fig. 6, 8B, and 9; column 10 lines 38-49 and column 13 line 63 – column 14 line 2). The communications module is customized for vendors, manufacturers, or service providers or “is associated with one or more sponsors” (See column 15 lines 15-25) and the communications module is “managed by a party other than a user using the television tuning device” (See Fig. 13, Third-party content providers, Banking Partners, Retailers via AD engine). The communications module has a power management scheme that utilizes a screensaver in standby mode. The communications module performs the method of “detecting a first predetermined condition” (See column 17 lines 48-53) and “replacing displayed information on the display with advertising information in response to the first predetermined condition” (See column 18 lines 20-30). The

advertisements or "advertising information" is related to the users demographic standings, recent buying patterns, or browsing patterns or "the advertising information unrelated to any of the one or more sponsors" (See column 18 lines 27-29).

Regarding claim 2, "the first predetermined condition comprises elapsing of a predetermined length of time without user activity on any input device operatively coupled to the television tuning device" (See column 17 lines 42-53).

Regarding claim 3, "further comprising detecting a second predetermined condition" (See column 17 lines 53-56) where inherently the screensaver displaying "advertising information" would be replaced with "the displayed information" on the display in "response to the second predetermined condition".

Regarding claim 4, "the second predetermined condition comprises user activity on an input device operatively coupled to the television tuning device" (See column 17 lines 53-56).

Regarding claim 6, the communications module periodically downloads the advertisements from the Internet and inherently "caches" the advertisements so when the communications module displays the advertisements it "retrieves the advertising information as previously cached" (See column 18 lines 24-30).

Regarding claim 7, the communications module inherently "caches" the advertisements as they are downloaded as discussed in claim 6 above.

Regarding claim 8, the communications module is connected to the Internet (See column 7 lines 12-17) and the advertisements are downloaded from the Internet and inherently "cached" as discussed in claims 6 and 7 above (See column 18 lines 20-36).

Regarding claim 12, the communications module uses an Internet Explorer browser to display a TV picture and advertisements (See Fig. 10A and 10B). The advertisements are provided by an AD engine or “provided by an advertiser” (See Fig. 13, AD engine and Retailer) where inherently the advertisements are written in “a predetermined markup language” in order to be displayed within the Internet Explorer browser (See column 14 lines 49-55).

Regarding claim 13, “the predetermined markup language comprises HyperText Markup Language (HTML)” (See column 14 lines 49-55).

Regarding claim 15, the advertisements are targeted advertisements based on household’s demographic standings, recent buying patterns, or recent browsing patters or “selecting the advertising information based on information particular to a user” (See column 18 lines 24-30).

Claim 16 contains the limitations of claims 1 and 6 (wherein the communications module is run by software or “machine-readable medium having instructions stored thereon”, where the software executes the screensaver (See Fig. 6 and 9)) and is analyzed as previously discussed with respect to those claims.

Claim 17 contains the limitations of claims 12 and 16 and is analyzed as previously discussed with respect to those claims.

Claim 18 contains the limitations of claims 13 and 17 and is analyzed as previously discussed with respect to those claims.

Claim 19 contains the limitations of claims 15 and 16 and is analyzed as previously discussed with respect to those claims.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US006557756B1) in view of Carhart (US006622304B1).

Claim 5 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. However, Smith does not disclose that the advertisements "comprises an offering for sale of at least one of a good and a service, such that the user is able to immediately purchase the at least one of the good and the service".

Carhart discloses an interactive television system that utilizes the Internet. The system is able to offer the user various interactive services, i.e. interactive programming and interactive advertising (See Fig. 12C and 12D; column 16 lines 1-22). The interactive advertising "comprises an offering for sale of at least one of a good and a service, such that the user is able to immediately purchase the at least one of the good and the service" (See Fig. 12C, Order Now). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisements disclosed by Smith to "offer for sale of at least one of a good and a service, such that the user is able to immediately purchase the at least one of the good

and the service", as taught by Carhart, in order to provide a more convenient means for the user to purchase products and to increase revenues for the advertisers and service providers.

Claim 20 contains the limitations of claims 1 and 16 and is analyzed as previously discussed with respect to those claims. However, Smith does not disclose that the advertisements are "interactive advertising information" having at least "an interactive segment". Furthermore, Smith does not disclose that the communications module "detects user input device activity in relation to the interactive segment and performs a predetermined action in response to the user input device activity in relation to the interactive segment".

Carhart discloses an interactive television system that utilizes the Internet. The system is able to offer the user various interactive services, i.e. interactive programming and interactive advertising (See Fig. 12C and 12D; column 16 lines 1-22). The interactive advertising or "interactive advertising information" has at least "an interactive segment" (See Fig. 12C, Order Now, More Info, Sweepstakes). Furthermore, the system providing the interactive advertising inherently "detects user input device activity in relation to the interactive segment and performs a predetermined action in response to the user input device activity in relation to the interactive segment" in order to fulfill the users requests/commands (See Fig. 12C and 12D). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisements disclosed by Smith to be "interactive advertising information having at least an interactive segment" and to modify the communications module and software

therein disclosed by Smith to "detect user input device activity in relation to the interactive segment and performs a predetermined action in response to the user input device activity in relation to the interactive segment", as taught by Carhart, in order to enhance the users experience of using the system.

Regarding claim 21, inherently the system displays a "second advertising information on the display" when the user selects "More Info" on the interactive advertisement (See Carhart Fig. 12C, More Info).

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US006557756B1) in view of Carhart (US006622304B1) and Sposato (US005781228A).

Claim 9 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. However, Smith does not disclose that (1) the advertisements are interactive advertisements having at least "an interactive segment" and that the communications module "detects user input device activity in relation to the interactive segment and performs a predetermined action in response to the user input device activity in relation specifically to the interactive segment". Furthermore, Smith does not disclose that (2) the advertisements have at least "an exit segment" where the communications module would "detect user input device activity in relation to the exit segment".

(1) Carhart discloses an interactive television system that utilizes the Internet. The system is able to offer the user various interactive services, i.e. interactive

programming and interactive advertising (See Fig. 12C and 12D; column 16 lines 1-22).

The interactive advertising has at least "an interactive segment" (See Fig. 12C, Order Now, More Info, Sweepstakes). Furthermore, the system providing the interactive advertising inherently "detects user input device activity in relation to the interactive segment and performs a predetermined action in response to the user input device activity in relation specifically to the interactive segment" in order to fulfill the users requests/commands (See Fig. 12C and 12D).

(2) Sposato discloses an interactive television system that is able to display intervening informational segments during an interactive program. The intervening informational segments have an exit button that allows the user to return to the interactive program (See Fig. 4C; column 13 lines 30-41). Inherently, the system providing the intervening informational segments "detects user input device activity in relation to the exit segment" in order to fulfill the users request/command (See Fig. 4C).

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisements disclosed by Smith to have "at least an interactive segment and an exit segment" and to modify the communications module disclosed by Smith to "detect user input device activity in relation to the interactive segment and the exit segment and performs a predetermined action in response to the user input device activity in relation specifically to the interactive segment", as taught by Carhart and Sposato, in order to enhance the users experience of using the system and to increase the convenience to the user.

Regarding claim 10, the system “replaces the advertising information with the displayed information on the display in response to the user input device activity in relation specifically to the exit segment” as taught by Sposato (See Sposato column 13 lines 30-41).

Regarding claim 11, inherently the system displays a “second advertising information on the display” when the user selects “More Info” on the interactive advertisement (See Carhart Fig. 12C, More Info).

Claims 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US006557756B1) in view of Alexander et al. (US006177931B1).

Claim 14 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Furthermore, the “displayed information on the display comprises a tuned-to television channel” (See Smith Fig. 10A and 10B; column 17 lines 23-33). However, Smith does not disclose “replacing the displayed information on the display with the advertising information comprises tuning to a different television channel related to the advertising information being displayed”.

Alexander et al. (Alexander) discloses a television system where the television can automatically tune to a particular advertising channel at the time during the broadcast of a television program during which an advertisement is scheduled to occur or “replacing the displayed information on the display with the advertising information comprises tuning to a different television channel related to the advertising information being displayed” (See column 32 line 61 – column 33 line 9). Therefore, it would have

been obvious to one with ordinary skill in the art at the time the invention was made to modify the communications module disclosed by Smith to "replace the displayed information on the display with the advertising information comprises tuning to a different television channel related to the advertising information being displayed", as taught by Alexander, in order to provide alternative means of delivering advertisements to the communications module thereby efficiently utilizing the available bandwidth of the communications network.

Claim 22 contains the limitations of claims 1, 14, and 16 (wherein the advertisements are displayed within a screensaver by "tuning to a television channel", as taught by Alexander) and is analyzed as previously discussed with respect to those claims. Furthermore, the advertisements are displayed on the display (See Smith Fig. 10A), where the advertisements are from the advertising channel or "television channel" or "displaying advertising information on the display in conjunction with the television channel to which has been tuned", as taught by Alexander.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please take note of Gerszberg et al. (US006084583A) for their similar method of an advertising screen saver.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G Ustaris whose telephone number is 703-305-0377. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGU
September 21, 2004


VIVEK SRIVASTAVA
PRIMARY EXAMINER